UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GERNOT ROSSI

Appeal No. 2005-1033
Application No. 10/236,460

HEARD: July 14, 2005

Before FRANKFORT, PATE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8, 9, 15, 19, 21 and 22, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a method for ordering an item, such as, e.g., hardware, software and/or a service (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. Claim 9, the only independent claim on appeal, reads as follows:

> A method for ordering production goods, comprising the step of providing at least one automation component, said automation component automatically recognizing a need for at least one item and ordering said at least one needed item, wherein the automation component includes a budget for payment of the order.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Slotznick	5,983,200	Nov. 9, 1999
Spear et al. (Spear)	6,486,439	Nov. 26, 2002

Claims 9, 19 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Slotznick.

Claims 8, 9, 15, 19, 21 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Spear.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed October 6, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed August 5, 2004) and reply brief (filed December 8, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something

disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The anticipation rejection based on Slotznick

We sustain the rejection of claims 9, 19 and 21 under 35 U.S.C. § 102(b) as being anticipated by Slotznick.

Slotznick's invention relates to a system which serves as an intelligent agent, expedites electronically placed orders, purchases, deliveries or production instructions for a variety of goods and services, and carries out various delegated tasks, in the present or the future or repeatedly over time. One example of instructions to the system is "Send flowers to Jim Smith and his wife on their anniversary." In this example, the system learns to associate the phrase "Jim Smith and his wife" with a given name such as "James D. Smith." It learns to associate that given name with a variety of occasions, dates and shipping addresses. It can also learn the user's preferences for gift items such as flowers (e.g., price range per occasion). The system knows how much lead time is needed to ship the product to ensure delivery on the specified date.

Every day the system disclosed by Slotznick examines which orders must be executed to ensure "just in time" delivery of the required products and services. Then, it electronically orders, purchases, arranges payment for, and/or dispenses the required items. In addition, it may look up orders from previous years (or time cycles) and ask the user if he or she wants to repeat the order in the current year (or time cycle). On the day the system is to execute the order, and prior to execution, payment may be accepted (after automatic electronic verification) by pre-entered credit card account, business account or electronic currency. Prepayment is also possible (including by smart card or coins in a vending machine), but not necessary.

Slotznick sets forth (column 20, line 50, to column 21, line 60) an illustration of automated order shipping and dispensing at a future time as follows:

> Referring to FIG. 8, the first thing done every day (steps 140 and 142), is that the central processing unit compares the current date on its internal clock with the list of dates on which orders must be shipped, processed or dispensed (steps 144, 146 and 148). The central processing unit retrieves the list of those to be dealt with on the current day and processes them (steps 148, 150, 152, 154, 156, 158, 160, 162 and 164). For each item the central processing unit checks to see if the order must be shipped on the current day (step 150) and verifies the payment procedure prior to dispensing or shipping (step 152) (prepaid funds available or verification of credit card number and account viability). The central processing unit then executes the order (step 154) whether by creating and dispensing the item for collection and shipping, by transmitting an order to a remote location for dispensing the item for collection and shipping, by transmitting an order to a third party supplier for shipping the item, or otherwise by dispensing and transmitting the item (be it physical or electronic) as described above.

The transmission of orders is accomplished via various output devices and means using analog and/or digital signals and modems to convert between analog and digital, where appropriate. Transmission occurs over wires (such as coaxial cable, telephone wires and fiber optic cables) of various private or public systems including telephone systems and cable TV system. Alternatively, transmission occurs using electromagnetic waves (such as but not limited to microwaves and radio waves) through various media (such as air) or no media (such as the vacuum of space) of various private or public systems including but not limited to cellular phones, direct satellite transmissions, interactive broadcast television. In addition, the transmission occurs within private or public networks, and/or networks of networks, including but not limited to intranets and the Internet. By way of example, in one embodiment, the transmission of orders is a fax transmission to a third party merchandise supplier over public telephone lines. In another embodiment, the transmission of orders is by direct wireless computer-to-computer data transmission over the cellular phone network. Various other methods of transmission have been described above.

If the initial data entry device is a desktop PC, terminal, or telephone (or other entry device intended to be used by one individual), the user is given a list of items to be shipped on the current day for confirmation. Alternatively, the items could be shipped with confirmation later sent to the user that the items had in fact been shipped as previously instructed.

After shipping or dispensing an order, the device checks to see if the order is for a reoccurring occasion such as a birthday or holiday (step 156). If the occasion is reoccurring, then the occasion date for the next year is calculated (step 158) and the order is reentered for the following year (step 160). (In a stand-alone device, the order would not be reentered unless pre-paid or credit pre-authorized.)

As new entries are made during the day they are checked to ascertain if they must be shipped immediately (step 168) and if so, then processed (steps 152 and 154). Alternatively, the device examines the database periodically, at scheduled times during the day, for new orders that must be shipped immediately (step 166). If it finds any such orders (step 168), it verifies the payment (step 152) (e.g., prepaid funds on account or valid pre-entered credit card number) as part of a first subtask. It then ships or dispenses the orders (step 154) as part of a second subtask. The device checks to see if the orders are for a recurring occasion (step 156), and if so, calculates the next occurrence (step 158) and

> enters an appropriate order (step 160). It then continues the checking process (steps 170 and 172). As the device is shut down each day, or the user otherwise logs off, and power is turned off, the program ends (steps 174 and 176). If instead, the device remains on continuously, 24 hours a day, at the conclusion of each day (step 174), as it resets its internal time clock, it resets the program to the beginning (steps 140 and 142).

The appellant argues (brief, pp. 4-7; reply brief, pp. 2-4) that when the term "budget" is given its correct meaning, Slotznick does not disclose that its automation component includes a budget for payment of the order.

The United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

The appellant provides (brief, p. 4) the following definition of the term "budget" from Webster's 3rd New International Dictionary: "A plan for the coordination of

resources (as of money or manpower) and expenditures." "The amount of money available, required, or assigned to a particular purpose."

The appellant's specification provides (p. 11) the following with respect to Figure 1b:

> In accordance with the present invention, a budget is assigned to the automation component AK2 and/or industrial machine M2 for limited and unlimited access by the industrial machine M2 and/or automation component AK2. Assignment of the budget is implemented, for example, by payment transaction G3. This payment transaction G3 provides an instrument of payment for the automation component AK2 and/or industrial machine M2. An example of such an instrument of payment is at least a software code which is commensurate with a particular monetary value and serves as instrument of payment with respect to a supplier AN2 of production goods. Another process for establishment of a budget for the automation component AK2 and/or industrial machine M2 is characterized by payment transaction G2 which involves a transfer of funds from the customer K2 to the supplier AN2, so that the supplier AN2 has at his disposal a budget of funds.

In our view, the broadest reasonable meaning of the term "budget" as it would be understood by one of ordinary skill in the art, taking into account both the written description contained in the appellant's specification and the plain meaning provided by the above-quoted definition provided by the appellant is the amount of money available, required, or assigned to a particular purpose. This definition encompasses both (1) assignment of a budget by payment transaction G3 from the customer K2 to the automation component AK2 and/or industrial machine M2; and (2) payment transaction

G2 which involves a transfer of funds from the customer K2 to the supplier AN2, so that the supplier AN2 has at his disposal a budget of funds.

With that understanding of the term "budget," it is clear to us that Slotznick does disclose that its automation component includes a "budget" for payment of the order. In that regard, the prepaid funds on account disclosed by Slotznick constitute "a budget for payment of the order."

For the reasons set forth above, claim 9 is anticipated by Slotznick. Accordingly, the decision of the examiner to reject claim 9 under 35 U.S.C. § 102(b) is affirmed.

Dependent claims 19 and 21 have not been separately argued by the appellant. Accordingly, these claims will be treated as falling with parent claim 9. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). Thus, it follows that the decision of the examiner to reject claims 19 and 21 under 35 U.S.C. § 102(b) is also affirmed.

The anticipation rejection based on Spear

We will not sustain the rejection of claims 8, 9, 15, 19, 21 and 22 under 35 U.S.C. § 102(e) as being anticipated by Spear.

Spear's invention relates generally to computer and welding systems, and more particularly to a system and method providing local and/or remote technical information transfers to welders via a weld object that provides links to the most recent welding operating, training, troubleshooting and servicing information, wherein users may determine/select replacement components from the information and automatically initiate orders associated with a replacement part selection. Figure 1 illustrates a system 10 having an automated welding information parts and welder program distribution architecture in accordance with Spear's invention. The system 10 includes a welding system 20. One or more remote interfaces 32 and 34 (e.g., web browser) interact with the welding systems 20 across a network 30 and enables a welding operator or user to service, maintain and/or update the welding systems. One or more welding information brokers 60 are employed to facilitate retrieval of the most recent welding information at the remote interfaces 32 and 34. The welding information broker 60 interrogates a local bus 64 to determine the particular hardware components and/or software that define the welding system 20. When welding technical information is requested by the remote interfaces 32 or 34, the welding information broker 60 is linked

to the technical information server 54 to determine welding information that is applicable to the welding system 20.

Spear teaches (column 6, line 60, to column 7, line 63) that:

> The link may include updating the broker with list or table of codes indicating one or more most recent document version numbers or codes associated with the component version codes contained within the welding information broker 60. The broker examines document revision levels (e.g., level 2 versus level 3) within the local information store 50 to determine if the version levels are at a similar level as the updated document version levels within the welding information broker 60. If the information in the local information store 50 is at an older or lower revision, the welding information broker 60 and/or 61 can initiate a download of the latest technical information from the technical information server 54 to the local information store 50.
>
> It is noted, that before the download, the welding information broker 60, 61 can check/compare the compatibility of a new or updated version document with the existing hardware, and/or check compatibility with other software that coexists therewith, and/or with other welding programs/procedures that coexist. The broker also may check/verify certification requirements to determine if new upgrades will affect the welding procedure certification and if the welding procedure should be re-certified. Alternatively, the broker can obtain approval from a responsible party of the welding system 20-28 before the initiation of the download. As an alternative to the download, the welding operator or user may choose to view the latest technical information remotely from the technical information server 54. By establishing the link between the weld information broker 60 and the technical information server 54, relevant and up-to-date-welding information is retrieved automatically without causing the operator to search for the information or determine if the information is current. In this manner, much time is saved over conventional welding systems.
>
> After the welding information is retrieved from the local information store 50 or the technical information server 54, the welding operator may interactively operate, service, and maintain the welding system 20 via the remote interface 32 and/or 34 and the retrieved information. This may include providing training or

> servicing procedures from the local information store 50 and performing troubleshooting via welding diagrams such as schematics, for example. If it is determined that a hardware component needs to be replaced as part of routine servicing or troubleshooting, and/or if a new welder program/procedure is desired, the welding operator may initiate an automatic order of the component or program/procedure by selecting (e.g., mouse click part on a schematic) the component/program from the remote interface 32,34. As will be described in more detail below, the welding information broker 60 can be linked to an inventory and distribution system 74 wherein component and supplier information (e.g., part numbers, supplier address, price, shipping terms) are updated within the broker and associated with the hardware, software, and/or other version codes within the broker. An ordering system 76 (e.g., remote server) linked to the welding information broker 60 provides purchase history and related information for the welding system 20. The ordering system 76 includes information relating to an entity that purchased the welding system 20, billing and shipping addresses for the entity, and credit information concerning account status and warranty information associated with the welding system 20 and the entity. For example, if a replacement component is under warranty, a flag may be set within the ordering system 76 indicating that no charge is to be accessed relating to the replacement component. The ordering system 76 and the information contained therein enables automatic acquisition of the selected replacement component by linking the entity's billing, shipping and warranty information with the welding information broker 60, thus mitigating manual purchase order generation and negotiations involved with conventional welding systems.

The appellant argues (brief, pp. 4-7; reply brief, pp. 2-4) that when the term "budget" is given its correct meaning, Spear does not disclose that its automation component includes a budget for payment of the order. We agree. Using the definition of the term "budget" arrived at above, it is clear to us that Spear does not disclose that its automation component includes a "budget" for payment of the order. In that regard,

Spear never discusses the amount of money available, required, or assigned to his ordering system. Accordingly, Spear does not disclose "a budget for payment of the order."

For the reasons set forth above, claim 9 is not anticipated by Spear. Accordingly, the decision of the examiner to reject claim 9, and claims 8, 15, 19, 21 and 22 dependent thereon, under 35 U.S.C. § 102(e) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 9, 19 and 21 under 35 U.S.C. § 102(b) as being anticipated by Slotznick is affirmed and the decision of the examiner to reject claims 8, 9, 15, 19, 21 and 22 under 35 U.S.C. § 102(e) as being anticipated by Spear is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

CHARLES E. FRANKFORT Administrative Patent Judge	)	
WILLIAM F. PATE III Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

HENRY M. FEIEREISEN, LLC
350 FIFTH AVENUE
SUITE 4714
NEW YORK, NY 10118

JVN/jg